

REMARKS

This Reply under 37 C.F.R. §1.112 is being submitted in response to the outstanding Office Action mailed May 3, 2007. In view of the foregoing amendments and following remarks, reconsideration and allowance of this application are respectfully requested.

In the Office Action, claims 1 – 38 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action contends that the term “capable of” is indefinite. Applicant respectfully traverses this rejection. Section 2173 of the M.P.E.P. indicates that functional limitations are acceptable when they set definite boundaries on the patent protection sought. Specifically, M.P.E.P. § 2173.05(g) specifically gives as an example the acceptable use of the similar term “incapable”:

It was held that the limitation used to define a radical on a chemical compound as “incapable of forming a dye with said oxidizing developing agent” although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

Here, the functional language objected to clearly and definitely define properties of the bonding agent, i.e., it is able to produce a bond between platelet-shaped pigments, binding agent, and the cellulose-bearing substrate surface. This meets the requirements of 35 U.S.C. §112, second paragraph. Accordingly, the Examiner respectfully requests the Examiner to reconsider and withdraw the rejection of claims 1-38 under 35 U.S.C. §112, second paragraph.

Additionally, claims 1 – 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Carpenter et al. (EP 0717088). Applicant has presented numerous arguments as to why this rejection is improper and maintains the validity of these arguments. However, to further prosecution of this case, Applicant has amended claim 1 to include the limitations of claim 9, which limit the claims to a specific type of bonding agent. The Office Action specifically acknowledges that Carpenter et al. “does not specifically name a binding agent.” Since Carpenter does not specifically name a binding agent, it cannot reasonable

teach or suggest to a skilled artisan to use a metal complex as a binding agent, as is now required by independent claim 1.

Claims 1-38 are now directed to coating agents having a bonding agent capable of producing a bond between platelet-shaped pigments, a binding agent, and a cellulose-bearing substrate surface, where the bonding agent is a metal complex with one or more ligands, wherein the metal complex contains one or more metal cations which are selected from the group consisting of B, Al, Si, Ge, Sn, Pb, Ti, Zr, V, Cr, Mo, Mn, Fe, Zn and mixtures thereof and the metal complex has at least two functional groups or ligands which with hydroxyl groups form a complex or produce a covalent bond or are displaced out of the complex by hydroxyl groups with the formation of an oxygen-central cation bond.

Carpenter et al. does not disclose or suggest this type of bonding agent, specifically, a bonding agent capable of producing a bond between platelet-shaped pigments, a binding agent, and a cellulose-bearing substrate surface, wherein the bonding agent is a metal complex having the above-mentioned properties.

In view of the foregoing remarks, this application is now in condition for Allowance. Reconsideration is respectfully requested. The Examiner is requested to telephone the undersigned if there are any remaining issues in this application to be resolved.

Finally, if there are any additional charges, the Examiner is authorized to charge applicants' Deposit Account No. 19-5425 therefore.

Respectfully submitted,

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